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10/789,741

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Paul Boisvert
Serial No.: 10/789,741
Filed : February 27, 2004
For : Flash Valve
Examiner: Charles E. Phillips
Art Unit: 3751

REQUEST TO INTERVENE

Commissioner for Patents
Attention: John Doll
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As former representative of the above identified Applicant, I hereby respectfully request intervention by the Commissioner for Patents to approve a timely filed Request for Withdrawal as Attorney or Agent under 37 CFR 1.36 (b), hereinafter "Withdrawal". A copy of the Withdrawal and proof of mailing and receipt is attached as Exhibit A. This request to intervene is being submitted in response to learning from Examiner Randy Green that the Withdrawal, although timely filed, was to be denied due to the rule requiring "sufficient time for an Applicant to reply to an outstanding action". We respectfully submit that, in view of the facts outlined below and the attached Exhibits, our Withdrawal was filed in sufficient time to allow for a positive decision and notification be provided to Applicant within the requirements of 37 CFR 1.36(b). Therefore, it is further respectfully submitted that, in the interest of justice, the Request for Withdrawal be approved.

In October of 2004 we were contacted by Applicant's representatives, J. Scott Montana and Stephen Tabah to respond to an outstanding Notice of Missing Parts for Applicant. A response to the Notice of Missing Parts was timely filed on behalf of Applicant. The response included a Preliminary Amendment in order to satisfy the outstanding informalities of the Application (not filed by me) identified by the Office of Initial Patent Examination. Specifically, the original application was filed in a language other than English and the translation provided by Applicant needed to be significantly amended to comply with US Patent practice. Additionally, the drawings required significant amendments and new claims were prepared. In preparing the Response to the Missing Parts, a significant amount of

time was expended resulting in a debit note in the amount of \$6471.52 including Patent Office Fees advanced by myself. This debit note was originally transmitted to Applicant on November 17, 2004 and the entire amount is currently outstanding.

A Restriction Requirement having a mailing date of August 15, 2005 was received on August 17, 2005. We promptly reported receipt of the Restriction Requirement to Applicant and provided instructions to the Applicant regarding responding thereto. In our report letter, we informed Applicant's Representative that we required payment of the outstanding debit note prior to performing additional work to ensure that the Applicant did not go abandoned. We placed several telephone calls and provided the client with numerous e-mail reminders of the upcoming due date of September 15, 2005. We received no response or other communication in any form from our client.

On October 6, 2005 a Notice of Non-Compliant Response was received indicating that a Response had been filed by a person other than myself or the Applicant and that the response did not comply with USPTO requirements and formalities. I contacted Examiner Phillips to determine the nature of the response filed and to which the Notice referred. The Examiner provided me with a response that was filed by Stephen Tabah. Upon receiving the Notice, we immediately contacted Mr. Tabah and explained that he could not properly respond to the Restriction Requirement because he was neither an Agent nor Attorney Registered to practice before the USPTO nor was he the named Applicant. At this time, we informed him of the due date of October 30, 2005 set for responding to the Notice and reminded him of the outstanding balance due for services previously rendered.

A further Notice was received on December 27, 2005 that another improper response was filed on October 30, 2005 by Mr. Tabah. This Notice indicated that the response was not signed by a person authorized to sign for Applicant and thus was not a bona fide response. We emailed Mr. Tabah on December 27, 2005 a copy of the Notice and reminded him that he was not authorized to file papers for Applicant and indicating that a proper response (including a request for Extension of Time) must be filed to maintain the pendency of the Application. To this communication, we also received no response.

The Withdrawal, attached as Exhibit A, was filed by Express Mail Post Office to Addressee service on January 11, 2006 and was received at the Office of Initial Patent Examination on the same date.

After additional phone calls and attempts to reach Mr. Tabah, we sent a letter dated January 17, 2006 to both Mr. Tabah and the Applicant (Paul Boisvert) informing them that a Request to Withdraw as Attorney was filed with and received by the USPTO on January 11, 2006. The letter informed Mr. Tabah and Mr. Boisvert that our Withdrawal was due to the lack of instructions received from Applicant and/or Applicant's Representative along with failure to pay or attempt to arrange payment of the outstanding debit note. This notice also advised them to retain other counsel in order to protect their rights.

During February and March, we placed numerous calls to Examiner Charles Phillips as well as to the Petitions Office in an attempt to check on the status of our Withdrawal. In each case we were told that the Petition was received but no indication as to when it would be acted on was provided. On March 13, 2006, we received a call from Examiner Randy Green. During the conversation with Examiner Green, we were informed that our Withdrawal Request would be denied because there lacked "sufficient time for the Applicant to file a response" because the six month date set to respond to the Notice of Non-Compliance is March 30, 2006. Examiner Green acknowledged that our Withdrawal was timely filed. However, despite the Petition being received within the USPTO, the Petition did not get to the proper location and the Withdrawal was not presented for decision in a manner that would allow approval of the Withdrawal to comply with 37 CFR 1.36(b).

In view of the above presented facts, it is respectfully requested that Commissioner for Patents intervene and approve the timely filed Request to Withdraw as Attorney despite the rule requiring 30 days between "*approval* of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time" (MPEP 402.06). Specifically, the Request was filed on January 11, 2006 (80 days before a final response was due) and was not acted upon for over 60 days. Had the Request been acted upon in a timely fashion, the Withdrawal and approval of the withdrawal would have complied with Rule 36(b). Furthermore, the time period set for which to reply to the outstanding actions has continued to run due to the lack of instructions from Applicant or Applicant's Representative on how to respond to the outstanding action in

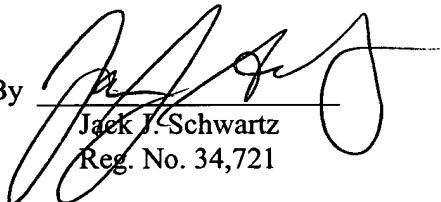
conjunction with the numerous improper filings by Mr. Tabah. The lack of instructions and improper responses along with the 60 day delay in acting on the timely filed Withdrawal has brought us within the time period that prevents the Petitions Office from granting our Withdrawal despite our best efforts to ensure compliance with 37 CFR 1.36(b). This time period expires on March 30, 2006 and cannot be further extended. Therefore, in the interest of justice, it is respectfully requested that the Commission for Patents intervene and that the Withdrawal be approved.

Alternatively, should the Commissioner have any questions, comments, or feel that a personal discussion might be helpful in deciding this Request, he is cordially invited to contact Mr. Jack J. Schwartz, Esq. of Jack Schwartz & Associates located at 1350 Broadway, Suite 1510, New York, NY 10018, telephone number (212) 971-0416.

Accordingly, it is respectfully requested that the Request for Withdrawal as Attorney or Agent under 37 CFR 1.36 be approved.

Respectfully submitted,
Jack J. Schwartz

By



Jack J. Schwartz
Reg. No. 34,721

Jack Schwartz & Associates
1350 Broadway, Suite 1510
New York, NY 10018
Tel: (212) 971-0416
Fax: (212) 971 - 0417

Dated: March 27, 2006